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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,007	05/08/2001	Satomi Shigaki	Q64408	9373

7590 06/14/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
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TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/850,007

Applicant(s)

SHIGAKI, SATOMI

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 12-14, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 9-11 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 15-17 are rejected under 35 U.S.C. 101 because claims 15-17 are directed to a recording medium readable by a computer, a computer data signal, and a program product.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory process. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Ando et al (US 6,901,208 B2).

Regarding claim 9, Ando et al discloses a recording/reproducing device (Fig. 19) of broadcasting signals comprising:

a receive unit (TV tuner 1544 of Fig. 19, col. 23, lines 42-49) which receives broadcasting signals of a program on a channel;

a manage unit (TV tuner 1544, video encoder 1553, audio encoder 1554, and sub-picture encoder 1555 of Fig. 19, col. 23, lines 28-48) which picks up program information from the received signals of program and analyses the program information;

a storage device (disc changer 1500 of Fig. 19, col. 23, lines 27-37) which stores recording files (the recording files is anticipated by the 2048 bytes packs disclosed in col. 25, lines 12-21);

a decoder unit (decoder unit 1560 disclosed in col. 26, lines 41-61) which decodes the received signals of program to obtain image data and sound data; and

a data control unit (and system controller 1530 of Fig. 19, col. 23, lines 27-37, col. 26, lines 10-40, and col. 27, lines 25-44) which supplies the received signals of program to the decoder unit under control of the manage unit, and supplies the received signal of program to the recording/reproducing manage unit to record the signals into the recording files each of which has a predetermined size in order until a recording stop instruction is received or broadcasting of the program is ended, and reproduces

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and supplies the recording files thus produced in the recording/reproducing manage unit to the decoder unit in response to a reproduction instruction.

Regarding claim 10, Ando et al discloses the claimed wherein the reproduction instruction is issued after at least one recording file is filled with a part of the signals (col. 27, lines 56-65).

Regarding claim 11, Ando et al discloses the claimed wherein the data control unit controls to delete a recording file which has reproduced (erasing capability disclosed in col. 15, lines 61-67).

***Allowable Subject Matter***

6. Claims 1-8, 12-14, and 18-19 are allowed.

Claims 1-8, 12-14, and 18-19 are directed to method/apparatus for recording/reproducing broadcasting signals. Each independent claim identifies the uniquely distinct feature "establishing/establishes a size of recording files based on a broadcasting time of a program to be recorded and capacity of a storage device". The closest prior art. Ando et al (US 6,901,208 B2) and Bruls (US 2002/0012530 A1) disclose conventional video disc recorder, either singularly or in combination, fail to anticipate or render the above underlined limitation obvious.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to video recorder.

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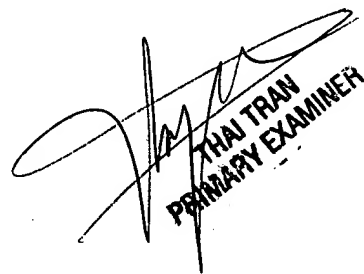
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN  
PRIMARY EXAMINER